

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TADEUSZ STANISZEWSKI

Appeal No. 98-1200
Application 08/589,780¹

ON BRIEF

Before CALVERT, MEISTER, and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Tadeusz Staniszewski appeals from the final rejection of claims 18 through 23, all of the claims pending in the

¹ Application for patent filed January 22, 1996.

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application. We reverse.

The invention relates to a device "for mounting a machine element with a bore coaxially onto a shaft, for common movement with the shaft" (specification, page 1). Claim 18 is illustrative and reads as follows:

18. A mounting device, for mounting an element having a central bore, on a shaft, via said bore, for movement of said element in common with said shaft, comprising:

a split sleeve dimensioned to be receivable within said bore; and

means for (a) envelopment of at least a portion of said sleeve, (b) entering said bore, (c) clamping said sleeve into fast, radial-gripping engagement with the shaft, (d) expanding into fast, radial-gripping engagement with said bore, and (e) impressing an axial force against the element.

The references relied upon by the examiner as evidence of obviousness are:

Lewis	1,195,482	Aug. 22,
1916		
Staniszewski	5,067,846	Nov. 26,
1991		

Claims 18 through 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Staniszewski in view of

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Lewis.

Reference is made to the appellant's main and reply
briefs (Paper Nos. 12 and 14) and to the examiner's final
rejection and
answer (Paper Nos. 4 and 13) for the respective positions of
the

appellant and the examiner with regard to the merits of this
rejection.²

As indicated above, independent claim 18 recites a
mounting device comprising, inter alia, a split sleeve

² On page 3 in the answer, the examiner refers to U.S. Patent Nos. 5,590,565 to Palfenier et al. and 5,203,861 to Irwin et al. to support his position on appeal. Neither of these references, however, appears in the statement of the appealed rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Accordingly, we have not considered the teachings of Palfenier et al. or Irwin et al. in reviewing the merits of the examiner's rejection.

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dimensioned to be receivable within the bore of an element to be mounted on a shaft and "means for (a) envelopment of at least a portion of said sleeve, (b) entering said bore, (c) clamping said sleeve into fast, radial-gripping engagement with the shaft, (d) expanding into fast, radial-gripping engagement with said bore, and (e) impressing an axial force against the element."

In explaining the appealed rejection, the examiner states that

Staniszewski discloses a mounting device substantially the same as applicant's with the exception of a shoulder [i.e., a "means for . . . entering said bore"]. Lewis teaches the use of a shoulder 22 for the purpose of supporting a wheel W. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the device of Staniszewski as taught by Lewis [final rejection, page 2].

The appellant submits that this rejection is unsound because Staniszewski and Lewis, even if combined in the manner proposed by the examiner, would not result in a mounting device meeting the limitation in claim 18 requiring "means for . . . expanding into fast, radial-gripping engagement with said bore."

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The appellant's position here is well taken. Staniszewski and Lewis contain no suggestion whatsoever of a mounting device having means for expanding into fast, radial-gripping engagement with the bore of an element being mounted on a shaft. The examiner's apparent contention that Staniszewski's nut members 36 and 38, as modified in view of Lewis to include shoulders extending into bore 11 of element 10, would expand into fast, radial-gripping engagement with the bore if they were made of a plastic or malleable material (see pages 3 and 4 in the answer) is not persuasive. Even if these nut members were made of a plastic or malleable material, it would be unduly speculative to conclude that they would expand into a fast, radial-gripping engagement with the bore. In short, Staniszewski and Lewis simply do not provide the factual basis necessary to conclude that the mounting device recited in claim 18, with its "means for . . . expanding into fast, radial-gripping engagement with said bore," would have been obvious to one of ordinary skill in the art.

Accordingly, we shall not sustain the standing 35 U.S.C.

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§ 103(a) rejection of claim 18, or of claims 19 through 23
which depend therefrom, as being unpatentable over
Staniszewski in view of Lewis.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
JAMES M. MEISTER)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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JPM/pgg
Bernard J. Murphy
P.O. Box 713
Hopatcong, NJ 07843